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EXAMINER

FLETCHER, JAMES A

ART UNIT PAPER NUMBER

2616

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/662,230	<b>Applicant(s)</b> ANDO ET AL.	
	<b>Examiner</b> James A. Fletcher	<b>Art Unit</b> 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,6 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 6, and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2616

### **DETAILED ACTION**

1. Please include the new Art Unit 2616 in the caption or heading of any written or facsimile communication submitted after this Office Action because the examiner, who was assigned to Art Unit 2615, will be assigned to new Art Unit 2616. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

### ***Response to Arguments***

2. Applicant's arguments filed 4 August 2004 have been fully considered but they are not persuasive. Note that due to the amendments changing the dependency of the claims, arguments toward the independent claims will be addressed first.

In re page 9, applicant's representative states: "Tada does not teach to 'search for the representative image,' or to reproduce index file to 'search for the representative image.'"

The examiner respectfully disagrees. The device in Tada reads the index file (Col 4, lines 42-45 "When the singer designates one music piece number, the index file 54 is searched and a music piece data and a BGP script data which are to be read out are designated"), which tells the reader where to search for the representative image.

In re pages 9 and 10, applicant's representative states: "Tada does not teach at least 'reproducing said program chain information to search for the representative image, and reproducing the audio information corresponding to the searched representative image,' as required by claim 15," and further states in the footnote: "Tada teaches searching for music piece number without reproducing the index file."

The examiner respectfully disagrees. The interpretation of Tada in the footnote on page 10 appears incorrect, in that Tada clearly and distinctly indicates a search being performed on the index file. Clearly, this cannot be done without reading the index file and reproducing it in the memory of the reading device.

**In re page 7**, applicant's representative states: Tada fails to teach 'dividing said first audio information managed in the music reproduction unit into second audio information and third audio information,' as required by claim 5."

The examiner respectfully disagrees. As noted in the non-final rejection, the apparatus disclosed by Tada clearly indicates demarcation of divisions of the audio information, each noted by the switching of still picture data.

**In re page 8**, applicant's representative states: "switching pictures among a picture sequence does not necessitate a division of audio information. Therefore, Tada does not teach 'dividing...audio information managed in the music reproduction unit,' and further fails to teach 'dividing said first audio information managed in the music reproduction unit into second audio information and third audio information,' as required by claim 5."

If that were all Tada's apparatus were doing, the examiner would agree. However, as noted in the non-final rejection, the pictures are switched "in accordance with the progress of the music piece," and not simply sequenced independently. Referring again to Tada, Col 6, lines 20-23 "Each of the tracks...is configured by sequence data consisting of plural event data and duration data  $\Delta t$  respectively

Art Unit: 2616

indicating time periods between the events.” Clearly, this division of the audio information tracks into  $\Delta t$  units meets the limitations of claim 5.

**In re pages 8 and 9**, applicant’s representative states “Tada fails to teach ‘combining said fourth audio information and said fifth audio information to form sixth audio information,’ as required by claim 6,” and “the management information in the index file always maintains an one-to-one relationship between ‘a music piece data and a picture sequence data in correspondence with a karaoke music piece.’...”

Again, the examiner disagrees. The audio informations recited in the claims have no bounds beyond carrying audio information, being at least a fourth and fifth informations, and being combined into a sixth information which also has no bounds beyond those stated. Tada lists six separate and distinct audio informations, which combine into a seventh information used for presentation (Col 4, lines 12-14).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15, 1, 3, 5-6, and 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Tada (5,982,980).

**Regarding claim 15**, Tada discloses a method for reproducing music information from an information storage medium which records audio information associated with a representative image (Col 1, lines 54-55 “an index file which designates a music piece

data and a picture sequence data which correspond to a music piece”), one or more pieces of still image information including the representative image (Col 2, lines 23-28 “reading a picture designating data from the selected picture sequence data, combining a background still picture data and a foreground still picture data which are designated by the picture designating data, thereby producing a display still picture data”), and management information including program chain information indicating a sequence of reproduction of the audio information (Col 2, lines 2-3 “performance sequence data of a corresponding music piece”), the reproducing method comprising:

- reproducing the program chain information to search for the representative image (Col 2, lines 45-47 “the index file which designates a music piece data and a picture sequence data in correspondence with a karaoke music piece”); and
- reproducing the audio information corresponding to the searched representative image (Col 2, lines 47-50 “When a karaoke performance music piece is designated, a music piece data designated in the index file is read out from the music piece data file, and a karaoke performance is then executed”).

**Regarding claim 1**, Tada discloses an information storage medium for recording audio information and still image information, the information storage medium being configured to record:

- one or more music reproduction units for reproducing the audio information (Col 1, lines 39-43 “a music piece data file for storing plural music piece data,

and which reads out a designated music piece data from the music piece data file and executes a performance of a karaoke music piece”); and

- set information for setting one or more pieces of the still image information to represent contents of the music reproduction unit (Col 1, lines 54-55 “an index file which designates a music piece data and a picture sequence data which correspond to a music piece”)
- wherein the set information is provided for at least one of the music reproduction units, and a specific one of the pieces of the still image information configured to be displayed first in the music reproduction unit is set as a representative still image of the contents of the music reproduction unit (Col 9, lines 23-25 “the initial still picture is displayed so as to be superimposed on a title still picture showing the title of a music piece”).

**Regarding claim 3**, Tada discloses an information storage medium for recording audio, still image, and management information including one or more reproduction sequences for reproducing the audio information, the medium being configured to record:

- information for specifying or designating one or more pieces of the still image information to represent contents of the reproduction sequence in which the still image information is to be displayed (Col 1, lines 54-55 “index file which designates a music piece data and a picture sequence data which correspond to a music piece”)

- wherein, in a case where the still image information is configured to be displayed at the same time when the audio information is reproduced in accordance with the reproduction sequence, a specific one of the pieces of the still image information configured to be displayed first is set as a representative still image of the contents of the reproduction sequence (Col 9, lines 23-25 “the initial still picture is displayed so as to be superimposed on a title still picture showing the title of a music piece”).

**Regarding claim 5**, Tada discloses a method for setting a representative image, selected from one or more pieces of still image information, wherein the setting method uses an information storage medium for recording audio information, still image information, and management information indicative of a reproduction relationship between the audio information and the still image information (Col 2, lines 40-47 “the music piece data file for storing plural music piece data; the picture storing means for storing plural background still picture data and foreground still picture data; the picture sequence data storing means for storing plural picture sequence data in correspondence with the plural music piece data; and the index file which designates a music piece data and a picture sequence data in correspondence with a karaoke music piece”), comprising:

- providing one or more music reproduction units for reproducing the audio information which includes first audio information managed in the music reproduction unit (Col 2, lines 47-50 “When a karaoke performance music



piece is designated, a music piece data designated in the index file is read out from the music piece data file”);

- dividing the first audio information managed in the music reproduction unit into second audio information and third audio information (Col 4, lines 1-3 “The switching display is conducted on the basis of a BGP [Back Ground Picture] script data which is a picture sequence data” and lines 8-10 “The display still picture data is switched to another one in accordance with the progress of the music piece”); and
- recording, in the management information, a specific one piece of the still image information being coincident with the representative image of contents of the first audio information before being divided, as a representative image of contents of the second audio information and as a representative image of contents of the third audio information (Col 9, lines 23-25 “the initial still picture is displayed so as to be superimposed on a title still picture showing the title of a music piece”),
- wherein the second and third audio information can be used to reproduce music corresponding to the first audio information (Col 5, lines 26-30 “During the karaoke performance, the character display unit 23 generates character patterns of a title of a music piece, words, and the like, based on a character data read out from the music piece data”).

**Regarding claim 6,** Tada discloses a method for setting a representative image selected from one or more pieces of still image information, wherein the setting method

Art Unit: 2616

uses an information storage medium for recording audio information, still image information, and management information indicative of a reproduction relationship between the audio information and the still image information (Col 9, lines 23-25 “the initial still picture is displayed so as to be superimposed on a title still picture showing the title of a music piece”) comprising:

- providing one or more music reproduction units for reproducing the audio information which includes fourth audio information and fifth audio information managed in the one or more music reproduction units (Col 6, lines 20-24 “Each of the tracks ranging from the musical-tone track to the effect control track is configured by sequence data consisting of plural event data and duration data  $\Delta t$  respectively indicating time periods between the events”);
- combining the fourth audio information and the fifth audio information to form sixth audio information reproduced in the first reproduction unit (Col 2, lines 40-50 “the music piece data file for storing plural music piece data; the picture storing means for storing plural background still picture data and foreground still picture data; the picture sequence data storing means for storing plural picture sequence data in correspondence with the plural music piece data; and the index file which designates a music piece data and a picture sequence data in correspondence with a karaoke music piece. When a karaoke performance music piece is designated, a music piece data designated in the index file is read out from the music piece data file, and a karaoke performance is then executed”); and

- recording in the management information, the representative image of contents of earlier-reproduced audio information, as a representative image of contents of the sixth audio information, wherein the earlier-reproduced audio information indicates one of the fourth audio information before combining and the fifth audio information before combining, which one is reproduced earlier than the other after being combined (Col 1, line 66 - Col 2, line 4 “a karaoke apparatus which stores plural music piece data respectively corresponding to music pieces, each of the music piece data including a genre data and a performance sequence data of a corresponding music piece, and which executes a performance of a karaoke music piece by reading out a designated music piece data”), and
- wherein the sixth audio information can be used to reproduce music corresponding to the fourth and fifth audio information (Col 6, lines 20-24 “Each of the tracks ranging from the musical-tone track to the effect control track is configured by sequence data consisting of plural event data and duration data  $\Delta t$  respectively indicating time periods between the events”).

**Regarding claims 16-17 and 20-21,** Tada discloses a method and apparatus for reproducing the audio information and the still information from the medium of claims 1 and 3 (Col 2, lines 50-55 “In parallel with the performance of the karaoke music piece, a display still picture data which is produced by combining a background still picture data and a foreground still picture data on the basis of the picture sequence data designated in the index file is displayed on the monitor”).

**Regarding claims 18 and 19,** Tada discloses a method for recording management information with respect to the still image information of the representative still image on the medium of claims 1 and 3 (Col 2, lines 5-10 "picture storing means for storing plural background still picture data...in which plural picture designating data are arranged in time series, in correspondence with the plural music piece data").

**Regarding claims 22 and 23,** Tada discloses an apparatus for recording the audio information and the still image information on the medium of claims 1 and 3 (Col 2, lines 5-10 "picture storing means for storing plural background still picture data...in which plural picture designating data are arranged in time series, in correspondence with the plural music piece data").

### ***Conclusion***

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (703) 305-3464. The examiner can normally be reached on 7:45AM - 5:45PM M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached at (703) 305-4380.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, DC 20231


**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only).**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

JAF  
December 22, 2004

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600